REMARKS

After entry of this amendment, claims 1, 3-13, and 15-29 are pending. In the present Office Action, claims 1-12 and 23-29 were objected to as allegedly containing "intended use" features because of the phrase "configured to" in these claims. Claims 13 and 15-22 were rejected under 35 U.S.C. § 112, second paragraph. Claims 1, 3-11, and 23-29 were rejected under 35 U.S.C. § 102(b) as being anticipated by Tran, U.S. Patent No. 6,016,533 ("Tran"). Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tran in view of Wickeraad et al., U.S. Patent No. 6,490,654 ("Wickeraad"). Applicants respectfully traverse these rejections and request reconsideration.

Section 112 Rejection

Claim 13 was rejected under 35 U.S.C. § 112, second paragraph for a lack of antecedent basis for "the first value" in the "comparing" phrase of the claim. Applicants have amended the phrase to recite: "comparing each of the plurality of values to a first value corresponding to the first address." Applicants respectfully submit that the amendment addresses the rejection. Claims 15-22 were rejected for their dependency on claim 13, and thus the rejection of these claims is also addressed.

Intended Use Objection for "Configured to"

The Office Action objects to claims 1-12 and 23-29, asserting that the use of the phrase "configured to" in these claims is a statement of intended use and thus is not a positive recitation in the claim. Applicants respectfully disagree. The phrase "configured to" is not a statement of intended use, but is rather a broad recitation of structure synonymous with "having circuitry that". Accordingly, the features recited after "configured to" should be treated as positive recitations.

The Office Action asserts that the "configured to" language is a statement of intended use, referring to MPEP 2106 II (C). This section does cite a statement of intended use as raising a question as to whether the features limit the claims, but does not appear to shed light on which phrased invoke a statement of intended use.

In *In re Hutchinson*, 154 F.2d 135, 69 USPQ 138 (CCPA 1946), the court did not consider the preamble phrase "adapted for use in the fabrication of a metal template or the like" to "constitute a limitation in any patentable sense." The holding in *Hutchinson* was based on the limitation being in the preamble of the claim, not on the use of "adapted to" or "configured to" in the claim. Various other decisions, some of which are discussed below, hold that such claim limitations do have patentable weight in that they impose capability requirements. In other words, the limitation distinguishes over the prior art if the prior art does not teach a structure having the same capability recited in the claim. Accordingly, these decisions have held that "configured to" limitations are positive recitations.

Various instances of "configured to" in Applicants' claims accompany language that recites specific limitations of the corresponding element. In other words, the claims describe that the claim elements are physically configured to perform a certain function or have certain properties. Thus, to anticipate such a limitation the prior art would have to describe an object that at least had the same ability. Applicants' respectfully submit that Tran and Wickeraad do not have the capabilities recited in the claims (see the response filed on March 9, 2009). The Office Action appears to conclude that Tran's hardware teaches the recited features if his hardware is not precluded from performing the recited features (Office Action, item 4, second to last sentence). Applicants respectfully disagree. The prior art must specifically teach the same features in order to anticipate the features.

The use of functional limitations to define an invention has been expressly approved by the courts. *See, e.g.*, *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). In fact, the Court has held that a functional claim limitation can distinguish over the prior art "because it set definite boundaries on the patent protection sought." *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971). Moreover, the Court has held that limitations using "configured to" or "adapted to" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re*

Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). Applicants also refer the Examiner to the claim construction using "configured to" limitations in *State Street Bank & Trust Co. v. Signature Financial Group Inc.,* 47 USPQ2d 1596 (Fed. Cir. 1998). For at least all of these reasons, Applicants respectfully submit that the features following "configured to" in the claims must be given full patentable weight and must be specifically taught in the prior art to be anticipated or rendered obvious by the prior art.

Nevertheless, Applicants have amended the "configured to" features to recite that the elements implement the features "during use". This phraseology is equivalent to the intended meaning of "configured to" in the claims, and appears to address the objection.

Art Rejection

The section 102 and 103 rejections appear to rely on the interpretation of "configured to" as intended use. See Office Action, page 2, item 4 and page 3. Since the intended use issue is addressed as highlighted above, Applicants submit that claims 1, 3-12, and 23-29 are patentable over the cited art for similar reasons as claims 13 and 15-22.

CONCLUSION

Applicants submit that the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5500-97500/LJM.

Respectfully submitted,

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